UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,872	01/14/2000	Hitoshi Yanagawa	862-3206	7614

			EXAMINER

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ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/482,872	YANAGAWA, HITOSHI
		Examiner	Art Unit	
		Thierry L. Pham	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *32-68* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32-68* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

• This action is responsive to the following communication: an Amendment filed on 12/28/05.

• Claims 32-64 are pending, wherein claims 55-64 are newly added.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 58 & 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Preamble of claims 58 & 65 states "a host computer performing printing" and "abnormal diagnosis function" is unclear to the examiner. Is it a host computer that performs printing or a printer apparatus that performs printing? Is a host computer having an abnormal diagnosis function or a printer apparatus having an abnormal diagnosis function? Clarification is required. As for claims interpretations in accordance with original filed specification, the examiner herein interprets a printer apparatus for performing printing and having an abnormal diagnosis function.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 55-59 & 62-66 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohtani (US 6108099).

Regarding claim 55, Ohtani discloses a printing apparatus (printing apparatus 20, fig. 1) that receives print data from a host computer (host computers 30, 40, fig. 1) and prints, and that has an abnormal diagnosis function (abnormal conditions such as paper jam, paper-out, fig. 2) for various portions of the apparatus, said apparatus comprising:

• memory means (memory 3, fig. 2,) that stores information designating problem contents (i.e. paper jam, fig. 2) which are identification codes (paper-out, paper-jam, and toner empty are each having different codes, fig. 4-5) allocated depending on problem types (i..e. paper-jam, paper-out, figs. 4-5) in advance (col. 5, lines 18-25) and forwarding address information designating a forward address (i.e. email address where to order paper, figs. 4-6, col. 5, lines 63-67) which is a communication address of an other computer (address of network terminal, col. 2, lines 5-6 and col. 6, lines 5-45) connected to a network (network, fig. 1) to which the host computer is connectable; and

• communication means (LAN-I/F 9, fig. 1-2) that sends the information designating problem contents corresponding to a result of the abnormal diagnosis function and the forward address information.

Regarding claim 56, Ohtani further discloses the printing apparatus according to claim 55, wherein the information designating the problem contents include information not having the forward address information (no forwarding address for paper jam, fig. 7); and the host computer sends (col. 6, lines 34-37) the information designating the problem contents to the other computer (i.e. where to order toner/paper, paper, fig. 5) connected to the network and designated by the forwarding address information only when receiving the forwarding address information.

Regarding claim 57, Ohtani further discloses the printing apparatus according to claim 55, wherein plural sets (plural email addresses, fig. 4) of the forward address information corresponding to the types (corresponding to the type of problems, fig. 4) of

the information designating the problem contents are provided in the memory means (provided in memory 3, fig. 2).

Regarding claim 58, Ohtani further discloses a host computer (host computer 30, fig. 1) performing printing by connecting to a printing apparatus (printer 20, fig. 1) having an abnormal diagnosis function (printer having plurality of diagnosis functions, fig. 2) for various portions of the apparatus and by supplying printing data to the printing apparatus, and reporting problem content (fig. 5), wherein the printing apparatus comprises means that stores information designating problem content and forwarding address information designating a forward address (memory 3 for storing email address with respect to problem types, fig. 4), and communication means (Land interface 9, fig. 2) that sends the information designating problem content corresponding to a result of the abnormal diagnosis function and the forwarding address information (problem types and forwarding email address, fig. 6), the host computer comprising:

• receiving means (LAN 30a, fig. 1) that receives the information designating the problem content and the forwarding address information from the printing apparatus (from printer 20, fig. 5); and

• sending means (LAN 30a, fig. 1) that sends the received information designating the problem content to the following address ("reply-to" email address, fig. 6) designated by the received forwarding address information;

• wherein the information designating the problem content is an identification code (no paper, fig. 5) allocated depending on problem types in advance (based upon problem types, fig. 4); and

• wherein the forwarding address (email address of other network terminal, fig. 4, col. 2, lines 3-7) information is a communication address of the other computer connected to a network to which the host computer is connectable.

Regarding claim 59, Ohtani further discloses the host computer according to claim 58, wherein the information designating the problem content includes information not having the forwarding address information (no forwarding/reply email address, fig.

7), and the host computer further comprises communication means to send (col. 6, lines 34-37) the information designating the problem content (where to order toner/paper, fig. 5, col. 6-7) to the network and designated by the forwarding address information only when receiving the forwarding address information.

Regarding claims 62-64: Claims 62-64 are the method claims corresponding to the apparatus claims 55-57 (respectively). The method claims are included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 55-57 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 32-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hille (US 6400462), and in view Kageyama (US 6333790).

Regarding claim 32, Hille discloses a printing system (fig. 1) comprising:

• a printer apparatus (printer 11, fig. 1) including output means for performing a printing operation based on printing data transmitted via a communication line and notice means (communication cables 14-16, fig. 1) for sending to said information processing apparatus (computer 12, fig. 1) a notice showing a status of said printing apparatus (printer status, col. 2, lines 14-25); and

• an information processing apparatus (computer 12, fig. 1) including a display unit (display 13 of computer 12, fig. 1), a memory (inherently, all computers include a memory device for storing PC service tool software, col. 6, lines 28-60), identification means (PC service tool software incorporated within computer 12 for identifying errors sent from printer, col. 2, lines 14-67 and col. 6, lines 10-67, and col. 7, lines 18-21) for

identifying the notice sent by said notice means, and control means for 1) when the notice is identified as a first type of notice (i.e. printer's error displayed on computer 12, fig. 6), controlling the display unit to perform a display (displays printer's errors on computer's display 13, fig. 1) based on information corresponding to the first type of notice, which is stored in the memory in advance (computer 12 contains HTML files describing and solution for solving printer's errors, figs. 4-6, cols. 6-7), and 2), wherein the display is not a forwarding URL (not a forwarding URL, fig. 6) when the notice is identified as a second type of notice (HTML files contain different type of printer's errors including first and second types of errors, *and classifying different types of errors is well known and widely available in the art*), controlling the display unit to perform a request display countermeasure information corresponding to the second type of notice (computer 12 connects to the Internet periodically to download latest HTML files describing and solution for solving printer's errors, figs. 4-6, col. 2, lines 14-67 and cols. 6-7),

• wherein said information processing apparatus is connected to the internet (computer 12 connects to the Internet periodically to download latest HTML files describing and solution for solving printer's errors, figs. 4-6, col. 2, lines 14-67 and cols. 6-7), and wherein a display based on the countermeasure information which is obtained via the internet based on the downloaded is displayed on the display unit of said information processing apparatus.

Hille explicitly teaches PC computer 12 for periodically downloading the latest HTML files from the Internet describing the printers' errors and providing a solution for such errors and such HTML files are stored on its memory device in advance for future usage, but Hille fails to explicitly teach a print system wherein it displays a forwarding first URL website for prompting an operator to instruct whether or not to connect to the Internet to for which corresponding countermeasure information is not stored locally in response printer's errors; in order words, Hille's system periodically retrieving/downloading countermeasure information in advance for future usage rather than displaying the URL websites to the operators when the problems exist/occur (wherein corresponding countermeasure information is not stored locally but rather remotely, for example, service computer and/or manufacturer's database).

Kageyama, in the same field of endeavor for solving printer's errors, teaches countermeasure information for printer's error is not stored locally but rather remotely (user of pc 300 issues an inquiry to pc 400 for countermeasure information regarding printer's error, fig. 7, col. 10, lines 10 to col. 11, lines 12, which is well known in the art).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify PC service tool software of Hille (col. 6, lines 10-60) to issue an inquiry to remote computer for countermeasure information regarding printer's errors as taught by Kageyama; in other words, one of ordinary skill in the art would also pre-store URL addresses (i.e. address where HTML files are downloaded) along with HTML files in advance and issue an inquiry using provided URL addresses to remotely computer that having a countermeasure information corresponding to each of printer's error because of the following advantages: (●) provides capabilities of resolving printer's errors by viewing countermeasure either from local storage device and/or from remote website; (●) resolving printer's error by viewing countermeasure from local storage device when Internet connection is not available. Please note, Hille also teaches an Internet Browser running on a computer 12 for connecting to the Internet, fig. 6.

Therefore, it would have been obvious to modify Hille's invention by downloading just the URL addresses and issuing an inquiry to remote computer for countermeasure information regarding printer's error as taught by Kageyama to obtain the invention as specified in claim 32.

Regarding claim 33, Hille further discloses the system according to claim 32, wherein, when the notice is identified as a third type of notice, the control means controls the display unit to display a request display of requiring a connection to a second URL (different HTML files and/or URL correspond to different type of errors, cols. 6-7) via the internet that is different from the first URL and is to obtain countermeasure information corresponding to the third type of notice.

Regarding claims 34-36, Hille further discloses the system according to claim 32, wherein the first type of notice corresponds to a problem that can be eliminated by a simple operation performed by an operator and by a serviceman (fig. 6, cols. 6-7).

Regarding claim 37, Hille further discloses the system according to claim 32, wherein said printer apparatus comprises an inkjet printer (printer 11, fig. 1, col. 1, lines 30-55 and col. 9, lines 13-30).

Regarding claims 38-42 recite limitations that are similar and in the same scope of invention as to those in claims 32-36 above; therefore, claims 38-42 are rejected for the same rejection rationale/basis as described in claims 32-36.

Regarding claims 43-47: Claims 43-47 are the method claims corresponding to the apparatus claims 32-36 (respectively). The method claims are inherent and included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 32-36 above.

Claims 48-52 corresponds to claims 32-37 except computer readable memory medium for storing program is claimed rather that printing system or data output apparatus. All computers have some type of computer readable memory medium (col. 6, lines 50-55 of Hille) for storing computer programs, hence claims 48-52 would be rejected using the same rationale as in claims 32-52.

Regarding claim 53, Kageyama further teaches the printing system according to claim 32, wherein said identification means (identification, col. 10, lines 10-67) includes a classification table showing whether the notice is the first type or other types (classifying different types of errors is well known and widely available in the art).

Regarding claim 54, Kageyama further teaches the printing system according to claim 32, wherein the display in said information processing apparatus and the instruction by the operator is processed by a printer driver (printer driver user interface 3130, fig. 3, col. 10, lines 10-67, which is also well known and widely available in the art) installed in said information processing apparatus.

Claims 60-61, 67-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani as described in claim 58, and in view Kageyama (US 6333790).

Regarding claim 60, Ohtani fails to teach and/or suggest the other computer sends to the host computer an answer corresponding to the information designating the problem content transferred via the communication means.

Kageyama, in the same field of endeavor for printing, teaches the other computer sends to the host computer an answer corresponding to the information designating the problem content transferred via the communication means (user of pc 300 issues an inquiry to pc 400 for countermeasure information regarding printer's error, fig. 7, col. 10, lines 10 to col. 11, lines 12, which is well known in the art).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify printing system of Ohtani to send an inquiry to other host computer for countermeasure/answer information regarding printer's error (i.e. paper jam) as taught by Kageyama because of the following advantages: (●) usability of the printer can be improved (col. 11, lines 5-9 of Kageyama); (●) quick turnaround time for solving problems without having to wait for service technician on errors that can be fixed by an operator (i.e. paper jam, out-of-paper, out-of-toner, and etc).

Therefore, it would have been obvious to combine Ohtani with Kageyama to obtain the invention as specified in claim 1.

Regarding claim 61, Ohtani further discloses the host computer according to claim 60, wherein plural sets (plural email addresses, fig. 4) of the forwarding address information corresponding to types of the information designating the problem contents are provided in the memory means of the printing apparatus (provided in memory 3, fig. 2).

Regarding claims 67-68: Claims 67-68 are the method claims corresponding to the apparatus claims 60-61 (respectively). The method claims are inherent and included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 60-61 above.

Response to Arguments

Applicant's arguments with respect to claim 32 have been considered but are moot in view of the new ground(s) of rejection. A new ground(s) of rejection is made in view of different interpretations of previous applied cited prior arts of record *due to newly added features/limitations* as cited in independent claim 32. In addition, newly added claims 55-68 are rejected under newly found prior art reference.

Applicant's arguments, see page 15, filed 12/28/05, with respect to claims 48-51 have been fully considered and are persuasive. The U.S.C. §101 rejection (non-statutory subject matter) of claims 48-51 has been withdrawn.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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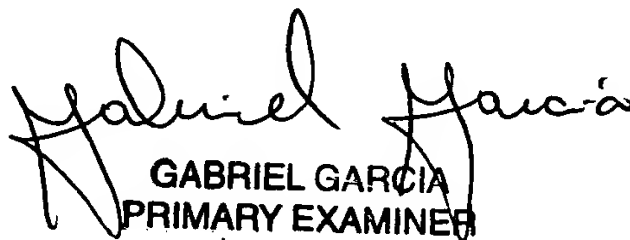
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

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PRIMARY EXAMINER